



UNITED STATES PATENT AND TRADEMARK OFFICE

ST

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/897,871	07/02/2001	Heather A. Bowen-Leaver	00.30US	1385

7590 07/05/2005

KAREN A. LOWNY, ESQ.
ESTEE LAUDER COMPANIES
155 PINELAWN ROAD, SUITE 345 SOUTH
GREENWAY PLAZA
MELVILLE, NY 11747

EXAMINER

YU, GINA C

ART UNIT PAPER NUMBER

1617

DATE MAILED: 07/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/897,871

Applicant(s)

BOWEN-LEAVER ET AL.

Examiner

Gina C. Yu

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-11, 13, 15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-11, 13, 15 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

88

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 11, 2005 has been entered.

Response to Amendment

The amendment to the claims filed on 4/11/2005 does not comply with the requirements of 37 CFR 1.121(c) because the text of canceled claims 3 and 12 are presented in the amendment. Amendments to the claims filed on or after July 30, 2003 must comply with 37 CFR 1.121(c) which states:

(c) *Claims*. Amendments to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).

(1) *Claim listing*. All of the claims presented in a claim listing shall be presented in ascending numerical order. Consecutive claims having the same status of "canceled" or "not entered" may be aggregated into one statement (e.g., Claims 1–5 (canceled)). The claim listing shall commence on a separate sheet of the amendment document and the sheet(s) that contain the text of any part of the claims shall not contain any other part of the amendment.

Art Unit: 1617

(2) *When claim text with markings is required.* All claims being currently amended in an amendment paper shall be presented in the claim listing, indicate a status of "currently amended," and be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. Only claims having the status of "currently amended," or "withdrawn" if also being amended, shall include markings. If a withdrawn claim is currently amended, its status in the claim listing may be identified as "withdrawn—currently amended."

(3) *When claim text in clean version is required.* The text of all pending claims not being currently amended shall be presented in the claim listing in clean version, *i.e.*, without any markings in the presentation of text. The presentation of a clean version of any claim having the status of "original," "withdrawn" or "previously presented" will constitute an assertion that it has not been changed relative to the immediate prior version, except to omit markings that may have been present in the immediate prior version of the claims of the status of "withdrawn" or "previously presented." Any claim added by amendment must be indicated with the status of "new" and presented in clean version, *i.e.*, without any underlining.

(4) *When claim text shall not be presented; canceling a claim.*

(i) No claim text shall be presented for any claim in the claim listing with the status of "canceled" or "not entered."

(ii) Cancellation of a claim shall be effected by an instruction to cancel a particular claim number. Identifying the status of a claim in the claim listing as "canceled" will constitute an instruction to cancel the claim.

(5) *Reinstatement of previously canceled claim.* A claim which was previously canceled may be reinstated only by adding the claim as a "new" claim with a new claim number.

In this case, the text of the canceled claims, claims 4, 12, and 14 should not be presented with the amended claims. Appropriate correction is required in response to this Office action.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term “at least” in claims 1 and 6 render the claims vague and indefinite because the numerical range is open-ended and includes an indefinitely large number . See 2173.05(c) (III).

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1-3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Diec (US 6468551 B1).

Diec teaches a W/O microemulsion having finely dispersed oil droplets. See col. 2, lines 15 – 24. The reference teaches that micellar compositions have particle diameters of less than about 100 nm and appear clear and transparent. See col. 2, lines 25 – 27. The reference teaches that oil phase can be hydrocarbon oils, and “furthermore advantageously have a content of cyclic linear silicone oils” in addition to other oil phase. See col. 25, lines 48 – 53. Cyclomethicone is particularly mentioned. See col. 25, lines 48 – 53; instant claim 5. The reference teaches that the content of the oily phase range from 0.01-30 % by weight. See col. 25, lines 54 – 56. The reference also teaches that O/W emulsifiers are used in the amount ranging from 0.01-15 % by weight. See col. 25, lines 57 – 66. See instant claim 2. The reference also teaches that it is disadvantageous to have high amount of surfactant. The reference also teaches

that emulsifier-free or low-emulsifier microemulsions and nanoemulsions are made by applying a high-pressure homogenization. See col. 24, lines 39 – 41. See instant claim 1, the limitation “by a high /shear/pressure treatment”.

While the reference fails to teach the “difference in complex viscosity” of the composition, examiner notes that this limitation is a physical property of the claimed composition. Since the prior art teaches the claimed composition obvious, examiner views that the recited physical property is an obvious property of the prior art.

Given the ranges of the oil phase and the emulsifiers in Diec, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have optimized the weight amount of the emulsifiers as suggested by the reference because of an expectation of successfully producing a topical microemulsion gel composition with lesser amount of surfactants.

2. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Claudelli (US 4026818) in view of Diec (US 6468551 B1).

Claudelli teaches transparent ringing gels for cosmetic use, comprising mineral oil, water, and 5-9 percent by weight of (2 ethyl 1,3-dihydroxy) 2-propyl oleamide. See col. 1, lines 5 – 63. The reference teaches transparent gels are obtained due to the small particle size of the dispersed droplet, which allows rapid absorption on skin of active ingredients contained in the composition. The reference teaches using low ratios of emulsifier to oil could be achieved, which is less costly. The reference teaches that it is well known in the art that clear ringing gel appeal to consumers. See col. 1, lines 5-9.

The reference teaches that minimum of 5 % of emulsifier (2-ethyl-1,3-dihydroxy) and maximum amount of 19.5 % of an oil phase (isostearic acid and mineral oil).

While the reference fails to teach the 5:1 ratio of oil phase and emulsifier as claimed by applicants, examiner notes that differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. See MPEP § 2144.05. Since the general conditions of the instant claims are disclosed in Claudelli, examiner views that one having ordinary skill in the art would have discovered the optimum or workable ranges by routine experimentation. Lowering the concentration of emulsifier is also suggested in the reference.

The reference also fails to teach using silicone oil.

Diec, discussed above, teaches "advantageously" using silicone oil in the oil phase. See col. 25, lines 43-53. The reference also teaches using the emulsifiers and the oily phase within the claimed weigh ratio. The reference also teaches that it is advantageous to have lower amount of emulsifiers.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition of Claudelli by adding silicone oil as suggested by Diec because of an expectation of successfully producing an improved cosmetic gel.

3. Claims 7-11, 13, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Claudelli and Diec, and further in view of Kakoki et al. (U.S. Pat. No. 5,162,377) ("Kakoki").

Claudelli and Diec fail to teach the shearing process as claimed by the instant claims.

Kakoki teaches the process of making a transparent emulsion cosmetic composition by applying high-shearing treatment to the composition. In the reference high shearing force treatment is carried out by high-pressure homogenization using emulsifiers such as Microfluidizer which is used in the present invention, or Manthon Gaulin, under a pressure of 500 psi or more. See col. 4, line 44 – col. 5, line 23. The Examples 4-13 shows treating the emulsion compositions with Manthon Gaulin at least 5-10 times to obtain transparent aqueous compositions.

Given the teaching in the combined references that high-pressure homogenization process is used to produce a nanoemulsion in Diec, one of ordinary skill in the art at the time the invention was made to have would have known looked for prior arts such as Kakoki for specific types of homogenizer and method steps to carry out the process to make the said composition, and treated the pre-emulsion with high shearing force to produce transparent compositions.

Response to Arguments

Applicant's arguments filed 3/11/2005 have been fully considered but they are not persuasive.

Applicants assert that the Diec microemulsion is different from the present invention in that the prior art uses crosslinking or thickening agents which, according to applicants, are excluded from the present claims. Applicants assert that the term "self-structure" means the absence of thickeners in the claimed composition and refers to the

supports in the specification at p. 4, [0014] and at p. 7, [0021]. However, the specification in fact teaches that the present gel is made "without a substantial amount" of thickening agents. See p. 4, [0014]. Applicants go on to define that "without a substantial amount" of thickening agents means less than 5 %. Diec teaches using thickening agents in the amount ranging from 0.3-20%, preferably 1-10 % by weight. Thus, even though applicants call the present composition is without a substantial amount of thickening agent, it still encompasses the presence of up to 5 % of thickening agent, which is clearly within the range of the prior art. The claim as recited does not define the composition as devoid of thickening agents. Examiner would favorably consider the claims if the claims are amended to positively exclude the thickening agents in the independent claims and to clearly distinguish the present invention from the prior art.

Conclusion

No claims are allowed.

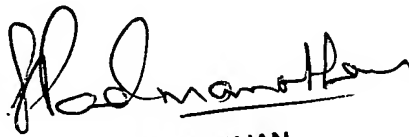
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-8605.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu
Patent Examiner



SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER